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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,216	11/10/1999	YOSHIHIRO TERADA	046601-5028	7662
9629	7590	12/22/2003	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			BRINICH, STEPHEN M	
			ART UNIT	PAPER NUMBER
			2624	
DATE MAILED: 12/22/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Office Action Summary	Application No.	Applicant(s)	
	09/437,216	TERADA ET AL.	
	Examiner Stephen M Brinich	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 September 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 4 is/are allowed.
- 6) Claim(s) 1-3,5-8,10,12,14 and 15 is/are rejected.
- 7) Claim(s) 9,11 and 13 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-3, 5-6, 8, 10, 12, & 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaughnessy et al. or Ng et al.

Re claims 1, 5, 8, & 15, Shaughnessy et al. (column 5, line 66 - column 6, line 13; column 6, lines 48-58; column 14, lines 54-60) or Ng et al. (column 5, lines 10-25; column 5, line 59 - column 6, line 2) discloses an image processing arrangement in which a scanning system generates image data from an original document and a discriminating system determines whether a predetermined inhibit image (a highlighting) is present in the original image. An editing system then alters the image data (which at this point includes the highlighting image data), e.g. by deleting the elements in the highlighted region, if this inhibit image is found, in order to produce an output image. Alternatively, the editing system leaves image data in which no highlighting is found unaltered in the produced output image. A printout system stores the output of the editing system as hard copy.

Re claims 10, 12, & 14, the highlighting is recognized in the process of determining the locations of the highlighted area (Shaughnessy et al. column 4, lines 15-18; Ng et al. column 3, lines 47-50).

Re claims 2-3, a deletion of certain image elements inherently affects the order in which the elements are read out afterwards (by removing the deleted elements from the sequence), and, in cases where the deletions are sufficiently extensive, causes the non-deleted remainder of several pages to fit onto one page.

Re claim 6, the Shaughnessy et al. or Ng et al. scanner is a "predetermined image input system", inasmuch as it is known in advance that images to be processed will be supplied to the image processing system by this means.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaughnessy et al. or Ng et al. in view of Applicant's admitted Prior Art.

Re claim 7, Shaughnessy et al. or Ng et al. discloses a local inputting of image data (by scanning an original document) without the use of an "external device". The connection of

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external devices to send and receive image data in conjunction with confidential-image printout suppression is known in the art as shown for example by Applicant (Figure 13; page 2, lines 7-15). The use of the Shaughnessy et al. or Ng et al. image processing system to process image information from an external device in order to allow remote users to print edited documents would be an expedient obvious to one of ordinary skill in the art.

Allowable Subject Matter

5. Claim 4 is allowed.

6. Claims 9, 11, & 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

Re claim 4, the art of record does not teach or suggest the claimed selective image rotation in accordance with the output of an image selectively edited in response to the detection of an inhibit image.

Re claims 9, 11, & 13, the art of record does not teach or suggest the inversion of a gradation of a color signal in an inhibited image data portion.

Response to Arguments

8. Applicant's arguments with respect to claims 1-3 & 5-8 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues (Paper #5: page 9, lines 14-16) that the Watanabe reference fails to teach or suggest certain features of the claims as newly-amended. In particular, Applicant argues (Paper #5: page 9, line 17 - page 11, line 4) that Watanabe fails to teach or suggest the detection of whether or not the inhibit image is present based on data of the *original* image (but rather determines its presence based on a separate user input) and (Paper #5: page 11, line 5 - page 12, line 15) that Watanabe fails to teach or suggest processing of the *original* image data, including the inhibit image data, to produce an altered image (but rather generates the final output image from a separate filtered scan, from which the inhibit image data is already removed, of the input document).

In response to Applicant's amendment requiring that the detection of whether or not the inhibit image is present based on the original image data (as opposed to not further specified "image data", which could be read upon auxiliary data associated with an image) and that the original image data *including the inhibit image data* is used to generate altered image data,

Examiner has set forth new grounds of rejection in paragraphs 2 & 4 supra.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 703-305-4390. The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2600 Customer Service center at 703-306-0377.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 703-308-7452.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 703-872-9306.

Stephen M Brinich
Examiner
Art Unit 2624

smb, smb
December 3, 2003



THOMAS D.
~~TERESA~~ LEE
PRIMARY EXAMINER